

03/07/01

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Paper No. 13  
EJS

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re PageMart Wireless, Inc.

Serial No. 75/404,110

William A. Munck of Novakov & Davis, PC for PageMart  
Wireless, Inc.

Michael W. Baird, Trademark Examining Attorney, Law Office  
109 (Ronald R. Sussman, Managing Attorney).

Before Seeherman, Quinn and Hairston, Administrative  
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

PageMart Wireless, Inc. has appealed from the final refusal of the Trademark Examining Attorney to register KEEPING YOU IN TOUCH as a mark for "data and voice communication services, namely, providing paging and voice messaging services."<sup>1</sup> Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C.

<sup>1</sup> Application Serial No. 75/404,110, filed December 11, 1997 and asserting a bona fide intention to use the mark in commerce.

1052(d), on the ground that applicant's mark so resembles the mark KEEPING YOU CONNECTED, previously registered for, inter alia, "telecommunications services, namely local and long distance telephone communications services, voice mail message services, caller identification services, and paging services,"<sup>2</sup> that, if used in connection with applicant's identified services, it is likely to cause confusion or mistake or to deceive.

Applicant and the Examining Attorney have filed briefs; an oral hearing was not requested.

Preliminarily, we must discuss an evidentiary matter. With its appeal brief applicant has submitted printouts taken from the U.S. Patent and Trademark Office website of certain third-party applications and registrations. The Examining Attorney has objected to these documents, stating that their submission is untimely. The Examining Attorney also points out that when applicant timely submitted, during the prosecution of the application, a listing of just the registration or application serial numbers and marks, the Examining Attorney advised applicant that such a listing was insufficient to make the registrations/applications of record. The Examining Attorney is correct as to both of these points. However,

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<sup>2</sup> Registration No. 1,958,279, issued February 27, 1996.

we note that in its response to the first Office action applicant submitted a listing of registration/application serial numbers and marks, and the Examining Attorney made no objection at that time. Instead, in the second Office action, the Examining Attorney merely stated that third-party registrations are entitled to little weight on the issue of likelihood of confusion. By treating the registrations and applications listed in applicant's first response to be of record, the Examining Attorney has waived any objections to their consideration. Further, although the actual copies of the documents were untimely filed, because they essentially elaborate the listings, we have considered them as well.

In determining whether there is a likelihood of confusion between two marks, we must consider all relevant factors as set forth in **In re E.I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis under Section 2(d), two of the most important considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods or services. **Federated Foods, Inc. v. Fort Howard Paper Co.**, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Turning first to the services, we find that applicant's services are identical to certain of the services recited in the cited registration. Specifically, both the application and the registration are for paging services and voice messaging services. As such, we must deem them to be offered in the same channels of trade to the same classes of consumers. See **In re Elbaum**, 211 USPQ 639 (TTAB 1981).

We turn next to a consideration of the marks, keeping in mind the well-established principle that when marks appear on identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines. **Century 21 Real Estate Corp. v. Century Life of America**, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Although applicant recognizes that marks must be compared in their entirety, it asks us to give little weight to the fact that both of the marks involved herein begin with the words KEEPING YOU, and to focus on the third word in each mark to reach a conclusion that they are not likely to cause confusion. Applicant asserts that KEEPING YOU is a weak term which has been used in many marks. However, a closer examination of the third-party registrations on which applicant bases its position reveals

that they do not support such a conclusion. First, there are only 13 third-party registrations for KEEPING YOU marks,<sup>3</sup> and of these, three are for the mark, KEEPING YOU IN STICHES, two are for the mark THREE BAGS FULL KEEPING YOU WARM IN SAN FRANCISCO, and two are for KEEPING YOU ORGANIZED. Thus, in effect, there are only nine third-party KEEPING YOU marks. Moreover, these third-party registrations are for services or goods which are different from the paging and voice messaging services at issue herein. For example, KEEPING YOU GOING WHEREVER YOU GO is for automobile repair services; KEEPING YOU ORGANIZED is for office requisites such as paper files, folders, and envelopes; KEEPING YOU IN COLOR is for arts and craft paints; THREE BAGS FULL KEEPING YOU WARM IN SAN FRANCISCO is for sweaters and clothing store services; and KEEPING YOU IN STITCHES relates to sewing. Similarly, the third-party registrations for marks containing the phrase KEEP IN (as opposed to KEEPING IN), are for marks and/or goods or services which are different from those at issue herein.

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<sup>3</sup> Applicant also submitted third-party applications, but such applications are evidence of only the fact that the applications were filed, and cannot be used, as can third-party registrations, to show that a particular word or phrase has a particular significance. However, we have treated as third-party registrations those applications listed in applicant's response to the first Office action which, according to the copies submitted by applicant with its brief, have now issued as registrations.

Thus, they do not persuade us that the term KEEPING YOU in the cited mark should be treated as a weak phrase.

As a result, we cannot agree with applicant that the IN TOUCH and CONNECTED portions of applicant's and registrant's marks are the dominant parts of each, nor can we agree that our decision should be based on the differences between these portions. On the contrary, the words KEEPING YOU in both marks make a strong impression because they are the beginning of each mark. Further, it need hardly be said that as these words are identical the marks share a strong similarity in appearance and pronunciation. Moreover, the fact that the final word is different is not sufficient to avoid likelihood of confusion. When the marks are viewed in their entirety, they have, in addition to the similarities in appearance and pronunciation, a strong similarity in connotation. In saying this, we have noted applicant's argument that KEEPING YOU CONNECTED means a steady contact, while KEEPING YOU IN TOUCH implies intermittent contact. Although there may be subtle differences in the meanings of the marks when they are subjected to close analysis, we do not believe that consumers will undertake such an analysis. As applicant itself has recognized, the test for likelihood of confusion is not whether the marks can be distinguished

when subjected to a side-by-side comparison, and that in evaluating similarities between marks the emphasis must be on the recollection of the average purchaser who normally retains a general rather than a specific impression of trademarks. Applicant's brief, p. 8.

Applicant asserts that applicant's services are purchased only after careful inspection and not on impulse. However, it is common knowledge that voice mail and paging services are purchased by the public at large and, as the Examining Attorney points out, they are available on a monthly basis and are relatively inexpensive. Even if we were to assume that consumers did note the differences in the last words of the marks, in view of their strong similarities stemming from the identical beginning words and their connotation, and in view of the fact that they are used on identical services, consumers are likely to believe that the marks are variants of each other, and that they identify services emanating from the same source.

Finally, to the extent that there may be any doubt on the issue of likelihood of confusion, we must resolve such doubt in favor of the registrant and prior user. See **In re Pneumatiques, Caoutchouc Manufacture et Plastiques Kleber-Colombes**, 487 F.2d 918, 179 USPQ 729 (CCPA 1973).

Decision: The refusal of registration is affirmed.